Remarks

Claims 1, 2, 6, 7, 9, 11, 15, and 25 are pending. Claim 6 has been canceled. Claim 1 has been amended in an effort to advance prosecution. Applicants assert that this amendment presents no issue of new matter, as basis for the amendment can be found in the specification at least on pages 219-220. In addition, Claim 42 has been amended, the basis for which can be found at least on page 232, line 3 the disclosure. Further responses to the Examiner's comments in the Office Action dated August 18, 2008 are provided below.

Claim Rejections – 35 U.S.C. § 103

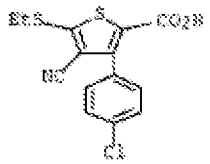
The Examiner has rejected Claim 1 and dependent claims under 35 U.S.C. § 103 as allegedly obvious in view of Abdulla et al. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) describes the factual inquiries that are applicable in determining obviousness:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Applicants discuss each factor below as it relates to the instant application and the above stated reference.

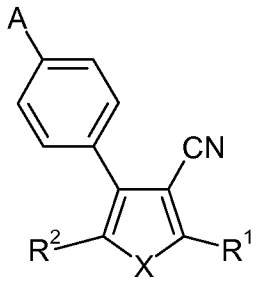
1. Ascertaining the differences between the prior art and the claims at issue.

Abdulla et al. discloses a compound of formula (b) below:

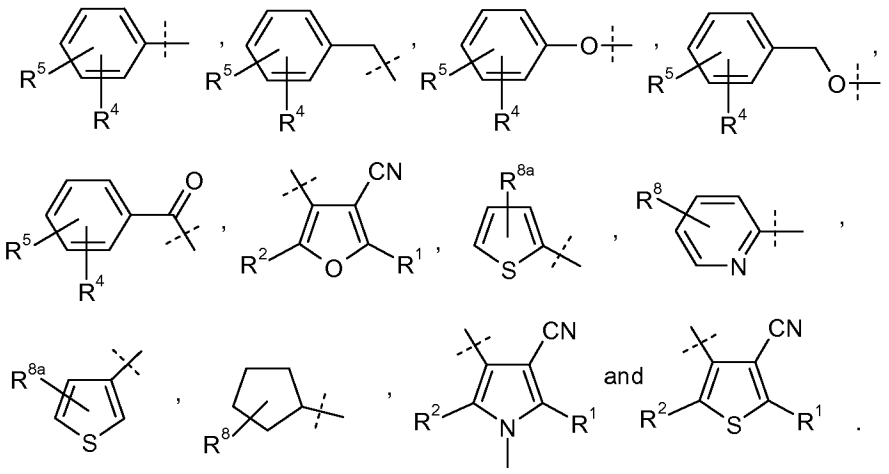


(b)

The claims at issue are drawn to compounds of the following formula:



wherein A is selected from the group consisting of $-(CH_2)_2NHSO_2R^{12}$, $-CH(CH_3)(CH_2)NHSO_2R^{12}$, $-(CH_2)CH(CH_3)NHSO_2R^{12}$,



2. Ascertaining the differences between the prior art and the claims at issue.

The examiner asserted that the difference between the prior art and the instant claims is a halogen substituent and that halogens "are suggestive of one another in the art of medicinal chemistry for the optimization of biological properties." Office Action dated August 18, 2008. However, Claim 1, as amended, is drawn to compounds wherein A is selected from the cyclic and alkylsulfonamide moieties depicted immediately above.

3. Lack of rationale and motivation for a Finding of Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further, a prima facie case of obviousness also requires a showing of "adequate support in the prior art" for the change in structure. Takeda Chem. Indus. v. Alphapharm Pty., Ltd., 2007 U.S. App. LEXIS 15349 (Fed. Cir. 2007) *citing* In re Grabiak, 769 F.2d 729, 731-32 (Fed. Cir. 1985). As such, "in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound." Takeda Chem. Indus. v. Alphapharm Pty., Ltd., 2007 U.S. App. LEXIS 15349, 12-13 (Fed. Cir. 2007)

Applicants assert that there is no teaching or knowledge in the art to modify halogen compound of Abdulla et al. to arrive at cyclic or alkylsulfonamide compounds of Claim 1 as amended. The Examiner has not pointed to any art which indicates that a chloro substitutent is interchangeable with the alkylsulfonamide or cyclic moieties depicted above, nor is it within the knowledge of one of ordinary skill in the art to make such a replacement. As such, the disclosure of compound (b) above in Abdulla et al. is in no way suggestive of the compounds encompassed in the scope of Claim 1, drawn to cyclic or alkylsulfonamide compounds. In view of the above arguments, Applicants assert that the instantly claimed compounds are not obvious in view of Abdulla et al. under 35 U.S.C. § 103(a). Applicants respectfully request allowance of Claims 1, 7, 9, 11, and 15.

Further, Claim 42, as amended, is drawn to pharmaceutical compositions comprising compounds of Formula I, or pharmaceutically acceptable salts thereof, and a pharmaceutically acceptable carrier, diluent, or excipient. Abdulla et al. discloses compounds purported to be useful as herbicides. Nothing in Abdulla et al. would suggest utilizing the compounds therein in combination with a pharmaceutically acceptable carrier, diluent, or excipient in a pharmaceutical composition. Applicants assert that Claims 1, 7, 9, 11, 15 and 42 as amended meet the requirements of 35 U.S.C. 103, and thus withdrawal of the rejection is respectfully requested.

Priority

Applicants respectfully request acknowledgment of foreign priority and receipt of the foreign priority documents. This is the national phase application, under 35 U.S.C 371, for PCT/US2005/000004, filed 01 January 2005, which claims the benefit under 35 U.S.C. 119 of EP 04380005.1 filed 9 January 2004, and of US provisional application 60/552,080, filed 10 March 2004. Applicants assert that they have complied with the provisions of 35 U.S.C 371 and

35 U.S.C 119, See File History, and are thus entitled to claim the benefit of priority of the above-referenced applications.

Applicants assert that in view of the amendments and arguments above, the claims are in condition for allowance which is respectfully requested The Examiner is invited to contact the undersigned attorney should any questions arise as a result of the submission provided herein, or in the event any question arise at any point during examination.

Respectfully submitted,

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